



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BRADLEY P. HEISLER
HEISLER & ASSOCIATES
3017 DOUGLAS BOULEVARD, SUITE 300
ROSEVILLE CA 95661

COPY MAILED

JUN 05 2007

OFFICE OF PETITIONS

In re Application of
WILLIAM CHARLES HISCOX
Application No. 10/707,699
Filed: January 5, 2004
Attorney Docket No. 05144.001

DECISION ON PETITION
UNDER 37 CFR 1.137(b)

This is a decision on the petition under 37 CFR 1.137(b), filed August 1, 2006, to revive the above-identified application.

The petition is **DISMISSED**.

BACKGROUND

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed March 4, 2005, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on June 5, 2005. A Notice of Abandonment was mailed on October 7, 2005.

Petitioner seeks revival of the abandonment of the above-identified application under the unintentional standard pursuant to 37 CFR 1.137(b).

STATUTE AND REGULATION

35 USC 41(a)(7) provides:

The Director shall charge the following fees: on filing each petition for the revival of an unintentionally abandoned application for a patent, for the unintentionally delayed payment of the fee for issuing each patent, or for an

unintentionally delayed response by the patent owner in any reexamination proceeding, \$1,500, unless the petition is filed under section 133 or 151 of this title, in which case the fee shall be \$500.

The patent statute at 35 U.S.C. § 41(a)(7) authorizes the Director to revive an "unintentionally abandoned application." The legislative history of Public Law 97-247 reveals that the purpose of 35 U.S.C. § 41(a)(7) is to permit the Office to have more discretion than in 35 U.S.C. §§ 133 or 151 to revive abandoned applications in appropriate circumstances, but places a limit on this discretion, stating that "[u]nder this section a petition accompanied by either a fee of \$500 or a fee of \$50 **would not be granted where the abandonment** or the failure to pay the fee for issuing the patent **was intentional** as opposed to being unintentional or unavoidable." [emphasis added]. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 6-7 (1982), *reprinted in* 1982 U.S.C.C.A.N. 770-71. The revival of, as here, an intentionally abandoned application is antithetical to the meaning and intent of the statute and regulation.

37 CFR 1.137(b) provides:

Unintentional. If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

OPINION

On October 3, 2005, the inventor and owner of the patent application was informed in an email communication by Michael Greenberg at Greenberg & Lieberman, who was prosecuting his patent application, that due to a switch in the docketing systems at the firm his application became inadvertently abandoned.

On October 4, 2005 dissatisfied with Greenberg & Lieberman, the inventor contacted attorney Bradley P. Heisler¹ (hereinafter "petitioner"), to enlist his services for revival of the abandoned application. Petitioner erroneously informed the inventor that he has "up to one year to revive the application before it becomes more difficult to do so ... [and] suggested that there is not any

¹ A power of attorney to Bradley P. Heisler was filed on August 1, 2006 along with the petition to revive under 37 CFR 1.137(b).

particular time pressure (other than the desire to get the case moving again so that you obtain your patent protection as soon as possible).”² Petitioner then sent a Legal Services Agreement for the handling the revival of the application to the inventor on October 30, 2005 that was signed and returned on January 9, 2006. Petitioner then docketed the revival of the application with a deadline of September 2006 and gave the revival “a relatively low priority”³ due to his misreading of the MPEP regarding abandonments. Petitioner further admits that he had a backlog of other projects/clients that took precedence over the present application. Approximately nine months later, on July 21, 2006 petitioner began work on the present petition for revival and realized his mistake regarding the time period for reviving an abandoned application. He then gave the present application his highest priority, and the resulting petition to revive was received at the USPTO on August 1, 2006.

Petitioner states that the inventor never intended to abandon the application. Petitioner further asserts that from October 4, 2005 until the filing of the petition that neither the inventor nor himself intended to purposely delay the submission of the petition.

The record indicates that petitioner has not met his burden of showing to the satisfaction of the Director that the “entire” delay herein was unintentional within the meaning of 37 CFR 1.137(b).

Petitioner states that the abandoned status of this application was first brought to his attention on October 4, 2005, but rather than then seek immediate revival of this application, petitioner placed the application on “low priority” and purposely delayed the revival of the application for up to one year.

The period from when the abandonment status was first discovered on October 4, 2005 until the filing of the petition to revive on August 1, 2006 cannot be deemed to be “unintentional.” In this regard, note the response to comment 64 contained in the Final Rule Notice, 62 Fed. Reg. at 53161:

an applicant who deliberately delays the filing of a petition under § 1.137 until three months from the mail date of the notice of abandonment (or based upon the one-year anniversary of the date of abandonment) cannot appropriately make the statement that “the delay was unintentional”

Thus, the record clearly shows an intentional delay in the prosecution of this application, and that applicant acquiesced to the abandoned status of this application, which militates away from a finding that the “entire” delay herein was unintentional. That an applicant may have been preoccupied with other matters that took precedence over the revival of an abandoned application is not viewed as an adequate justification for delay. See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Rather, the revival of an application that was not intentionally abandoned is the applicant's “most important business.” See Ex parte Pratt, 1887 Dec. Comm'r Pats. 31, 32-33 (1887). Specifically, an applicant seeking revival of an abandoned application is expected to file a petition under 37 CFR 1.137 promptly after discovering its abandonment See In re Kokaji, 1 USPQ2d 2005, 2007 (Comm'r Pats. 1986); see

² Declaration of Bradley P. Heisler, para. 5.

³ Declaration of Bradley P. Heisler, para. 6.

also Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. at 53161, 1203 Off. Gaz. Pat. Office at 88-89 (response to comment 65).

The Office requires that the entire delay was at least unintentional as a prerequisite to revival of an abandoned application to prevent abuse and injury to the public. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 7 (1982), reprinted in 1982 U.S.C.C.A.N. 771 ("[i]n order to prevent abuse and injury to the public the Commissioner . . . could require applicants to act promptly after becoming aware of the abandonment"). The December 1997 change to 37 CFR 1.137 did not create any new right to overcome an intentional delay in seeking revival, or in renewing an attempt at seeking revival, of an abandoned application. See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53160 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 87 (October 21, 1997).

While the "unintentional" delay standard in 37 CFR 1.137(b) is less stringent than the "unavoidable" delay standard in 37 CFR 1.137(a), the Patent and Trademark Office (PTO) has long and consistently held that a delay in seeking revival of an application resulting from a decision to use the revival procedures as an extension of time does not constitute an "unintentional" delay within the meaning of 37 CFR 1.137(b). See Changes in Procedures for Revival of Patent Applications and Reinstatement of Patents; Final Rule Notice, 58 Fed. Reg. 44277, 44278 (August 20, 1993), 1154 Off. Gaz. Pat. Office 35, 36 (September 14, 1993) (an applicant who intentionally delays filing a petition to revive cannot meet the requirement in 37 CFR 1.137(b) for a statement that the delay was unintentional) and Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991) (petitions to revive must be filed promptly after the applicant becomes aware of the abandonment).

Petitioner maintains that the inventor always intended to prosecute this application and petitioner simply placed the prosecution of this application on the "back burner" due to a misinterpretation of the MPEP by the petitioner. The fact that petitioner was in error is immaterial to the finding that petitioner had knowledge of the abandonment and instead of filing a petition to revive promptly, petitioner deliberately chose to delay and "causally pursued" the prosecution of this application⁴. According to In re Application of S, 8 USPQ2d 1630, 1632 (Comm'r Pats. 1988):

petitioner's deliberate deferral in filing a petition under 37 CFR 1.137(b) is an abuse of the procedures set forth in that regulation. The one year time period set forth in § 1.137(b) was never intended to be used as an "extension of time" and should not be so used by applicants or the representatives.

The petitioner's error does not excuse the petitioner from the resultant lack of compliance with the conditions of 37 CFR 1.137(b). See Nitto Chem. Indus. Co. v. Comer, 39 USPQ2d 1778, 1782 (D.D.C. 1994). Circumstances resulting from petitioner's failure to exercise diligence in filing a communication to the PTO, or lack of knowledge of, or failure to properly apply, the patent statutes or rules of practice are not, in any event, circumstances which warrant relief from the requirements of 37 CFR 1.137. See Nitto, supra; Huston v. Ladner, 973 F.2d 1564, 1567, 23

⁴ Declaration of Heisler, para. 6.

USPQ2d 1910, 1913 (Fed. Cir. 1992); Vincent v. Mossinghoff, 230 USPQ 621, 625 (D.D.C. 1985). Attention is drawn to Huston, supra:

if we were to hold that an attorney's negligence constitutes good cause for failing to meet a PTO requirement, the PTO's rules could become meaningless. Parties could regularly allege attorney negligence in order to avoid an unmet requirement.

Rather, the Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, supra; Vincent, supra; see also Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (D.N. Ind. 1987).

DECISION

For the reasons given above, petitioner has not demonstrated to the satisfaction of the Director that the entire delay herein was unintentional within the meaning of 37 USC 41(a)(7) and 37 CFR 1.137(b). Accordingly, this abandoned application will not be revived.

Telephone inquiries concerning this decision should be directed to Amelia Au at (571) 272-7414.



Amelia Au
Petitions Examiner
Office of Petitions